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10/508,962	09/25/2004	Wolf-Stephan Wilke	300001-0133	8207

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EXAMINER

TRUONG, THANH K

ART UNIT PAPER NUMBER

3721

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/508,962

Applicant(s)

WILKE, WOLF-STEPHAN

Examiner

Thanh K. Truong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to applicant's amendment received on September 12, 2006.
2. Applicant's cancellation of claims 8 and 9 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballestrazzi et al. (4,338,768) in view of Irvine (5,052,977) and Roou (4,841,712).

Ballestrazzi discloses (figure 1) a method comprising the steps of:

shrink-wrapped a mass mailing;

separating the strip of bags (1) into individual bag;

forming gaps between the bags for further processing (figures 2a, 2b).

Ballestrazzi discloses the claimed invention, but it does not expressly disclose that: the shrink-wrapped are done in strips of film, the strip of bags are hanging together at a respective destination, and the strip of bags are threaded into the sorting machine before being separated into individual bags.

Roou discloses the method of wrapping of the item in strips of film (48, 50) providing a top and bottom wrapping surfaces that are not interrupted by any sealing line (provides a clear view of the item being wrapped under the wrapping surface).

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Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Ballestrazzi method by incorporating the using of strips of wrapping film as taught by Roou providing a top and bottom wrapping surfaces that are not interrupted by any sealing line.

Irvine discloses (figures 7 & 8) a method in which the wrapping items 10 are hanging together in a string at a respective destination (figure 7), and the string of item (10) are threaded and separated into individual item (126 – figure 8). Irvine method provides a means to ship a folded strip of wrapped item in a carton (103) in a compact form to a respective destination before the string of item are separated into individual item for further distribution. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Ballestrazzi method by incorporating the method as taught by Irvine to a respective destination before the string of item are separated into individual item for further distribution.

The modified Ballestrazzi et al. by Roou and Irvine further discloses the steps of:

Regarding claims 2 and 11, the mass mailing is wrapped between two endless film strips (48, 50 – Roou).

Regarding claims 3 and 12, the shrink-wrapped mailings hanging together are stored in fan-fold form (figures 7 & 8 – Irvine).

Regarding claims 4 and 13, the shrink-wrapped mailings hanging together are stored in roll form (figure 6 – Roou).

Regarding claims 5 and 14, the strip of bags with the shrink-wrapped mailing is provided with perforation at the sides and the threading transport device of the material

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input of the sorting machines has transport gear wheels which engage in the perforations (Irvine – column 6, lines 9-18) (the examiner construes that it is obvious to use roller or gear wheels to engage and move the strips of item forward).

Regarding claims 6 and 15, following shrink-wrapping, each film bag is provided with an address sticker (7 – Ballestrazzi et al.).

Regarding claims 7 and 16, wherein the transparent film are used (the examiner construes that it is obvious that the transparent film are used in order for the user to be able to read the address sticker as discloses in figure 7 of Ballestrazzi et al.).

### ***Response to Arguments***

5. Applicant's arguments filed September 12, 2006 have been fully considered but they are not persuasive.

6. In response to the Applicant's argument that:

Ballestrazzi et al. teaches away from the invention and Roou reference does not cure the deficiencies of Ballestrazzi et al. and there is no suggestion or teaching that the process of Roou would be applicable to mass mailing to be sorted at a destination, and likewise Irvine does not cure the deficiencies of the Roou nor Ballestrazzi et al., and the combination is no more than hindsight reconstruction, this is not found persuasive, because:

First of all, Ballestrazzi et al. does not teach away from the invention. Ballestrazzi et al. discloses:

*"Labels with and without final item identification mark ... wrapping station followed by a film sealing and cutting station, a heating tunnel and ..."* (abstract) (emphasis added); and

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*"The present invention relates to an automatic machine for sorting items of correspondence, in particular magazines, into batches each having a different general destination.*

*"It is known to deliver to subscribers items such as magazines, either through the postal service or a carrier, after first providing them with a protective wrapping of polyethylene or the like that has, also internally, a label with the address and any other inserts of various kind" (column 1, lines 7-16) (emphasis added).*

Ballestrazzi et al. clearly teaches and suggests - shrink-wrapped a mass mailing as claimed by the presently claimed invention. It does not teach away from the presently claimed invention.

Secondly, in response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, Ballestrazzi et al. clearly teaches and suggests the shrink-wrapped a mass mailing, separating the strip of bags into individual bag, forming gaps between the bags for further processing as claimed by the presently claimed invention.

Roou discloses the method of wrapping of the item in strips of film providing an attractive wrapping surface that are not interrupted by any sealing line, and

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Irvine discloses a method in which the wrapping items are hanging together in a string at a respective destination, and the string of item are threaded and separated into individual item. This method provides a means to ship a folded strip of wrapped item in a carton in a compact form to a respective destination before items are separated into individual item for distribution.

The references taken as a whole would suggest to one ordinary skill in the art to combine and modify the references as taught by Ballestrazzi et al., Roou and Irvine as pointed out in paragraph 4 of this office action.

Finally, in response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

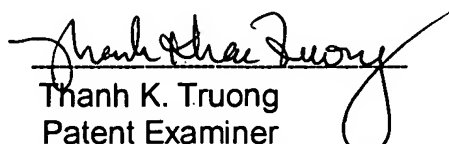
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thanh K. Truong  
Patent Examiner  
November 15, 2006.